

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 10-11, 13-18, and 20-29 are pending in the application. Claim 10 has been amended to better define the claimed invention. Claims 26 and 28 have been cancelled. The other claims remain unchanged notwithstanding the Examiner's rejections.

The Examiner's statement in paragraph 1 of the Office Action is noted. It appears to be the Examiner's intent to acknowledge cancellation of **claim 12**, rather than claim 14 as stated in the Office Action.

The Examiner's decision to withdraw the indicated allowability of claims 10-18 and 21-29 is noted.

The *35 U.S.C. 112* rejections of claims 26 and 28 are moot as these claims have been cancelled.

The *35 U.S.C. 102(b)* rejection of claims 20, 22-25 and 28 as being anticipated by *Oyama* (JP 03-136614) is traversed because the reference does not teach or disclose each and every element of the rejected claims.

Oyama discloses a drink-and-food cooking pack (claim 1 of *Oyama*) characterized in that

(1) the pack has

(a) a heat-resistant outer bag that is provided with a vapor-pressure releasing hole on its top face and a boiled-water releasing hole on its bottom face;

(b) a heat-resistant, food-and-drink storage bag that (i) is provided in said outer bag, (ii) stores foods or drinks, and (iii) allows boiled water to pass through; and

(c) a heat-resistant, liquid-storage bag that (i) stores liquid, and (ii) is provided in said outer bag while being overlaid on said drink-and-food storage bag; and in that

(2) when said outer bag is heated, said liquid in said liquid-storage bag is boiled, and as a result, boiled water flows out and pours onto the surface of said drink-and-food storage bag.

According to *Oyama*, the liquid stored in the liquid-storage bag is heated by an external heating means and is caused to flow out from the liquid-storage bag to the inside of the outer bag. Therefore, food ingredients stored in the drink-and-food storage bag can be cooked by the heated liquid. The liquid-storage bag is provided with a liquid-flow hole at its bottom, and a seal is adhered to the liquid-flow hole in such a way that the seal can be peeled off when a vapor pressure inside the bag reaches a predetermined level.

Oyama additionally discloses an alternative cooking method in which a liquid-(e.g., water)-storage bag is disposed on the bottom side and food is disposed on the top side. Thus, the food on the top side is *steamed* with vapor generated from the water bag disposed below. *Oyama* further requires that a fine net, or the like, composed of a synthetic material through which liquid can permeate be used for separating the food and the water bag. According to *Oyama*, it is also possible to configure the liquid-storage bag so that it explodes under certain conditions.

The device of the present invention has a vapor-releasing hole on the top part of the liquid-accommodation bag wherein the vapor-releasing hole is sealed so as to prevent the liquid from flowing out of the liquid-accommodation bag. The claimed liquid-accommodation bag allows vapor to escape from the top part of the liquid-accommodation bag when the liquid is sufficiently heated. Therefore, food ingredients are heated by the vapor that fills the inside of the outer bag, and the vapor emission rate can be suitably adjusted by the structure of the seal. This structure was neither disclosed by *Oyama* nor publicly known prior to the present invention.

Oyama has a different structure from that of the present invention in regard to the respective means for vapor-heating food ingredients. According to *Oyama*, a partition sheet is provided in the outer bag for positioning a liquid-storage bag on the bottom side of said outer bag, and food is disposed on the partition sheet, i.e., on the upper side of the outer bag, so that vapor can be used to steam the food. Thus, *Oyama* requires a partition sheet. Furthermore, the bottom part of the inside of the outer bag is soaked with boiled water. Under such a condition, however, a boiled-water-releasing hole cannot be provided in the bottom of the outer bag. For this reason, *Oyama* cannot yield, for example, a liquid or the like that is produced by passing vapor through the drink-and-food

storage bag.

In contrast, the present invention has a liquid-accommodation bag that has a vapor-releasing hole in the outer bag, thanks to which the bottom part of the inside of the outer bag can be soaked with boiled water, and therefore, unlike *Oyama*, a partition sheet for disposing food is not necessary. Therefore, the present invention is fundamentally different from *Oyama* in view of how vapor is generated.

Paragraph 11 of the Office Action states that how to provide a liquid-accommodation bag with a vapor-releasing hole is public knowledge. However, as mentioned above, the structure of the present invention differs from that of *Oyama*, because the present invention provides a liquid-accommodation bag whose outer bag has a vapor-releasing hole, thereby achieving excellent results.

In addition, *Oyama* does not anticipate independent claim 20 because the reference, *as applied by the Examiner*, fails to teach or disclose the claimed second *closed* inner (food-storage) bag.

Oyama discloses two different embodiments. The first embodiment in Figs. 1-9 includes two inner bags i.e., a liquid-storage bag and a food-storage bag. The liquid-storage bag is disposed above the food-storage bag and is provided with a bottom hole for releasing the heated liquid to an interior of the outer bag. The food-storage bag is immersed in the heated liquid and food ingredients in the food-storage bag are mixed with the heated liquid. The heated and mixed liquid is subsequently released from the outer bag through a bottom hole thereof. This embodiment lacks a vapor releasing hole in an upper part of the liquid-storage bag. A second embodiment of *Oyama* is disclosed in Figs. 10-13 with an outer bag containing a liquid-storage bag and food (F, Figs. 10-13) divided by partition wall 68. The liquid-storage bag can be disposed below the partition wall and the food can be positioned on top of the partition wall so that the food can be steamed by vapor escaping the liquid-storage bag. This embodiment, however, lacks a food-storage bag enclosing the food F.

The Examiner is deemed to rely on a “combined” embodiment which is *not* specifically disclosed by *Oyama* to reject independent claim 20 as being anticipated by the reference. It thus appears to be the Examiner’s position that *Oyama* discloses *through inherency* a food and drink

cooking pack having an outer bag, a liquid-storage bag having an upper vapor releasing hole, and a food-storage bag containing food therein. If so, Applicants respectfully disagree because the Examiner fails to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). “The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *See also MPEP*, section 2112.

In this case, the Examiner fails to provide a basis in fact and/or technical reasoning to reasonably support (i) either the determination that the food in the second embodiment (Figs. 10-13) of *Oyama* is *necessarily* contained within a second closed food-storage bag, or (ii) the determination that the liquid-storage bag in the first embodiment (Figs. 1-9) of *Oyama* does *necessarily* have an upper vapor releasing hole. Note the facts that the food of second embodiment may be placed in a closed food-storage bag and the liquid-storage bag in the first embodiment may be provided with an upper vapor releasing hole are *not* sufficient to establish anticipation through inherency.

Thus, unless the Examiner presents convincing evidence or persuasive arguments in support of his position that *Oyama* teaches or discloses the device of claim 20 through inherency, Applicants submit that the 35 U.S.C. 102(b) rejection of claim 20 is inappropriate and should be withdrawn.

The 35 U.S.C. 102(b) rejection of claims 22-25 is traversed for the reasons advanced above with respect to independent claim 20.

As to claim 23, if the Examiner holds that the second embodiment of *Oyama* inherently teaches a food-storage bag, then the burden will also be on the Examiner to prove that the second embodiment of *Oyama* inherently teaches a bottom hole in the outer bag. As can be seen in Figs. 10-13 of *Oyama*, the outer bag in the second embodiment does not have a bottom hole.

As to claim 24, if the Examiner holds that the second embodiment of *Oyama* inherently teaches a food-storage bag, then the burden will also be on the Examiner to prove that the second embodiment of *Oyama* inherently teaches that such a food-storage bag is bonded to the bottom of

the outer bag.

The 35 U.S.C. 103(a) rejection of claims 10-11, 13-15, and 18 as being unpatentable over *Oyama* in view of *Hoffman* is traversed because the references singly or in combination fail to disclose, teach or suggest all limitations of the rejected claims.

Hoffman discloses a heating element that comprises two separate chemicals that react together so as to constitute a source of heat for heating the liquid-containing bag. When the heating element is used, a vessel is compressed, and a partition of each compartment is torn down, so that an exothermic reaction can be generated in the compartment so as to heat the liquid. More particularly, with regard to the heating device, a diaphragm 19 and a separator 20 form compartments 23 and 24 *in the outer bag*. The compartment 23 accommodates a liquid reactant, and the compartment 24 accommodates a solid – and, particularly, a powdered reactant – for use in an exothermic reaction. For instance, the *Hoffman* patent states that the compartment 23 can be filled with a glycerine-water mixture, and that the compartment 24 can be filled with a blend of potassium permanganate, solid sorbitol, and silica gel. In addition, the compartment 23 is made to face the liquid to be heated, and the compartment 24 is made to face the outside of the container. Therefore, it is clear that neither of the compartments 23 and 24 is accommodated *inside* the liquid to be heated.

In amended claim 10 of the instant application, an internal heating element is installed in a first inner bag filled with a liquid. Thus, the internal heating element of the present invention is installed not merely in the outer bag but specifically *in the liquid-accommodation bag*. This feature finds support in the originally filed specification at page 3, lines 4-5 from bottom (“Further, as to a method for heating the outer bag, the problem is solved by installing a heating means in the liquid-accommodation bag.”) Thus, the invention of amended claim 10 clearly differs from that of *Hoffman*, because the heating element of *Hoffman* is configured so that the surface of one part of the heating element contacts the liquid. Accordingly, even if *Oyama* and *Hoffman* are properly combinable, the references would still fail to teach or disclose all limitations of independent claim 10.

The 35 U.S.C. 103(a) rejection of independent claim 10 is also traversed because the Examiner fails to meet the burden of proving that the primary reference of *Oyama* inherently

teaches either (i) a second closed food-storage bag in the second embodiment (Figs. 10-13), or (ii) an upper vapor releasing hole in the liquid-storage bag of the first embodiment (Figs. 1-9). *See* the above discussion of independent claim 20. The Examiner also fails to meet the burden of proving that the primary reference of Oyama inherently teaches a bottom hole in the outer bag in the second embodiment. *See* the above discussion of independent claim 23. Accordingly, even if *Oyama* and *Hoffman* are properly combinable, the references would still fail to teach or disclose all limitations of independent claim 10.

The 35 U.S.C. 103(a) rejection of independent claim 1-11, 13-15 and 18 is therefore inappropriate and should be withdrawn.

The 35 U.S.C. 103(a) rejection of claim 14 is also traversed for the reasons advanced with respect to claim 24.

The 35 U.S.C. 103(a) rejection of claims 16-17 is traversed for at least the reasons advanced with respect to independent claim 10 from which claims 16-17 depend.

The 35 U.S.C. 103(a) rejection of claim 21 is traversed for at least the reasons advanced with respect to independent claim 20 from which claim 21 depends.

The 35 U.S.C. 103(a) rejections of claims 27 and 29 are traversed for the reasons advanced with respect to independent claims 10 and 20. If the Examiner holds that the second embodiment of *Oyama* inherently teaches a food-storage bag, then the rejections of claims 27 and 29 are also traversed because *Oyama* is not modifiable in the manner proposed by the Examiner to include second closed inner bags disposed *around* the liquid-storage bag, because doing so would render the reference being modified, i.e., the second embodiment of *Oyama*, unsatisfactory for its intended purpose of *steaming* the food.

Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

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The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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A handwritten signature in black ink, reading "Kenneth M. Berner". The signature is written in a cursive, flowing style with a large initial 'K'.

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